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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/624,619 | 07/24/2000 | Kiyoshi Okamoto | CANO:011 | 6384 |

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EXAMINER

GOODMAN, CHARLES

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 06/04/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/624,619

Applicant(s)

OKAMOTO ET AL.

Examiner

Charles Goodman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/15/02 and Pet. Decision 5/1/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-23 and 26-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-23 and 26-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The Amendment filed on August 15, 2002 has been entered.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on August 15, 2002 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Election/Restrictions

3. In light of the petition decision mailed May 1, 2003, the restriction requirement with respect to the pending claims has been withdrawn notwithstanding the Applicant's election without traverse in Paper No. 7.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16-18, 22, 23, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i. The following phrases lack clear antecedent basis: (claim 16, l. 3) “the direction”.
- ii. In claim 17, the phrase “the direction at a right angle...” is not clearly understood in that it appears to be a double inclusion of the same previously recited.
- iii. In claim 22, the phrase “adapted for to an image forming apparatus...” is grammatically awkward, and it is not clear what the phrase encompasses.
- iv. In claim 23, l. 2, the phrase “controls timing the processing...” is grammatically awkward, and it is not clear what the phrase encompasses.
- v. Claim 26 is vague and indefinite in that it is not clear what the claim encompasses. Claim 11 sets forth that the “detecting means” detects the side edge of the sheet which is understood to be referring to the edge running in the conveying direction, yet the current claim now sets forth that the detection is occurring at the trailing end. What is the scope of the detecting means so that detection at both locations occur by the same “detecting means”?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 11-23 and 26-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamauchi et al.

Yamauchi et al discloses a paper punching device for use in an image forming machine comprising all the elements claimed including, *inter alia* in the various embodiments, a sheet processing means (e.g. 161) which is movable in the width direction; a conveying means (e.g. 168, 169); detecting means (e.g. 32, 164) with detects the side edge of the sheet; and a control means (e.g. Figs. 30-32, 39, 42-47(d), and 52) wherein the control means controls timing of the detecting operation. Note e.g., c. 29, l. 12 - c. 48, l. 27; “The photosensor 32 is designed to release an ON signal during *a period of time* from the detection of the leading edge of paper...” (emphasis added - c. 29, ll. 55-59); and “The sheet-side-edge sensor 164 is designed to release an ON signal during *a period of time* from the detection of the starting-side-edge of the sheet of paper...” (emphasis added - c. 29, ll. 61-67)

Response to Arguments

9. Applicant's arguments filed August 15, 2002 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that Yamauchi et al does not anticipate the claimed invention because Yamauchi et al allegedly does not detect the sheet edge near the sheet processing position, the detecting means movable in the width direction together with the sheet processing means, and the alignment of holes, this argument is traversed. First, it is not clear what point Applicant raises with respect to the detection near the sheet processing position. The detecting means which includes at least the photosensor 32 and sheet-side-edge sensor 164 is near the area in which the sheet is punched at least with respect to the side edge sensor 164 as exemplified in Figs. 25 and 33. The fixed constant distance as argued is of no moment, since on the one hand, the claims do not require any consideration thereof, and on the other hand the fact that the sensor is located and moves with the punching unit clearly teaches that the detection occurs near the sheet processing position. Second, as note *supra*, the detecting means moves together with the sheet processing means. Figs. 33-34, c. 29, ll. 60-67, c. 33, l. 58 - c. 34, l. 23. Thus, Applicant's argument fails to persuade. Third, the above noted Figures clearly show the alignment of punched holes which anticipates this limitation contrary to Applicant's argument.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703)


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308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

cg 
June 2, 2003


Charles Goodman
Primary Examiner
AU 3724

CHARLES GOODMAN
PRIMARY EXAMINER